

*REMARKS/ARGUMENTS**Summary of the Office Action*

The Examiner has issued a restriction requirement between the following groups of claims:

- (I) claims 1-9 (drawn to a compound of Formula (I));
- (II) claims 10 and 20 (drawn to a composition comprising a compound of Formula (I) and an additional therapeutic agent);
- (III) claims 11-13, 15, and 17-19 (drawn to a method of using a compound of Formula (I)); and
- (IV) claims 14, 16, 21, and 22 (drawn to a method of using a compound of Formula (I) with an additional therapeutic agent).

The Examiner also states that a single species must be elected in addition to a group.

Applicants' Election

Applicants elect, with traverse, the claims of Group I (i.e., claims 1-9) for examination. In addition, Applicants elect the species of Formula (I) in which R³ is methyl and each of R¹, R², R⁴-R⁸ and R^{9a} are H. This species is supported by the specification at, for example, page 10, lines 14-24.

Discussion of the Restriction Requirement

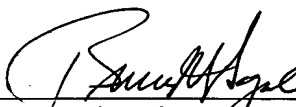
This application is a U.S. national stage application based on the international application PCT/US03/023290. Under PCT Rule 13 (37 C.F.R. § 1.475), a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. See, e.g., M.P.E.P. § 1893.03(d). The expression "special technical features" is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. *Id.*

The pending claims of the present invention are linked so as to form a single general inventive concept. In other words, the pending claims have in common a special technical feature, which defines the contribution that each claim makes over the prior art. For example, all of the pending claims include compounds of Formula (I). Given the special technical feature common to all of the claims, a search for prior art with respect to any one of the groups would likely uncover references that would be considered by the Examiner during the examination of the other groups. More specifically, the nature of the claims is such that references considered by the Examiner with respect to the claims of Group I would almost certainly be considered by the Examiner with respect to the claims of Group II inasmuch as claims 10 and 20 of Group II are directed to a composition comprising the compound of Formula (I) of claims 1-9 of Group I. Similarly, the nature of the claims is such that references considered by the Examiner with respect to the claims of Group I would almost certainly be considered by the Examiner with respect to the claims of Groups III and IV inasmuch as the claims of Groups III and IV are directed to a method of using the compound of claims 1-9 of Group I. Furthermore, the fact that the subject matter of Groups II, III, and IV substantially overlaps with the subject matter of Group I is at least *prima facie* evidence that there would be no undue burden on the Examiner to examine the claims of Groups I-IV together. In other words, if the compound claims of elected Group I are determined to be patentable, the composition and use claims of Groups II-IV also must be novel and unobvious. This does not mean that the claims necessarily stand and fall together, but the overlapping relevance of subject matter and references remains and mitigates against the restriction requirement.

Applicants, therefore, respectfully request withdrawal of the restriction requirement, and respectfully submit that the claims of Groups I-IV should be examined together. If, however, the restriction requirement cannot be withdrawn, applicants respectfully request that the claims of Groups II-IV (i.e., claims 10-22) be rejoined for examination in the event that the claims of elected Group I are found allowable. Such rejoinder would be appropriate since, as discussed above, the claims of Groups II-IV are drawn to a composition and methods of using the compounds of claim 1 of elected Group I.

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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